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EXAMINER

MACNEILL, ELIZABETH

ART UNIT

PAPER NUMBER

3767

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,633

Applicant(s)

HALEY, JEFFREY T.

Examiner

Elizabeth R. MacNeill

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 20-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group 1 (Claims 1-19) in the reply filed on 29 June 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3,5,6,10-12 and 14 rejected under 35 U.S.C. 102(b) as being anticipated by D'ALESSIO (US #6,283,933).

Regarding claim 1, D'Alessio teaches "A method for self-directing by touch a dose of liquid to be applied at a spot, comprising:

a. having an applicator (10) comprising a sheath (20) having a tip (26) with a hole (28) and, associated with the hole, a tactile surface (50), the applicator containing a liquid (in ampule 30) inside the applicator;

b. by feeling the tactile surface contacting touch sensitive tissues, placing the tip of the applicator along side a spot where liquid is to be delivered; and

c. activating the applicator, thereby releasing liquid from the hole onto the spot.

(Col 4 lines 8-19)

Regarding claims 2,3,11, and 12, the tactile surface both surrounds and is beside the hole. Examiner takes "beside" in the broadest reasonable interpretation to include the position illustrated in Fig 11, where the distal edge of the hole is abutting the proximal edge of the tactile surface.

Regarding claims 5 and 14, the tactile surface is absorbent (i.e. it absorbs the medicine from inside the applicator and carries it to the distal edge of the swab)

Regarding claim 6, the liquid is enclosed in the thin-walled packet 30

Regarding claim 10, D'Alessio teaches "An applicator with a tactile surface, comprising: (a) a sheath (20) having an interior cavity and a tip (26) with a hole (28) communicating with the cavity and, (b) associated with the hole, a tactile surface (50).

4. Claims 1,3,10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by SNYDER (US #4,432,749).

Regarding claims 1 and 9, Snyder teaches a method and apparatus:

a. having an applicator (10) comprising a sheath (12) having a tip (18) with a hole (16) and, associated with the hole, a tactile surface (18), the applicator containing a liquid (20) inside the applicator;

b. by feeling the tactile surface contacting touch sensitive tissues, placing the tip of the applicator along side a spot where liquid is to be delivered; and

c. activating the applicator, thereby releasing liquid from the hole onto the spot.
(Col 2 lines 1-36)

Regarding claims 3 and 13, the tactile surface is on the opposite side of the tip from the liquid by the plug 22.

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5. Claims 10 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by VIZSOLYI (US #5,636,933).

Regarding claim 10, Vizsolyi teaches "An applicator with a tactile surface, comprising: (a) a sheath (12) having an interior cavity and a tip (14) with a hole (50) communicating with the cavity and, (b) associated with the hole, a tactile surface (48).

Regarding claims 15-17, the applicator has an adjustable stop comprising a set of movable detents (62) which adjust the maximum depth of the plunger (See Fig 6) and which are integrally formed on the sheath.

6. Claims 10, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by LOSIER (US #6,030,138).

Regarding claim 10, Losier teaches "An applicator with a tactile surface, comprising: (a) a sheath (30) having an interior cavity and a tip (34) with a hole (not labeled) communicating with the cavity and, (b) associated with the hole, a tactile surface (22).

Regarding claims 18 and 19, the sheath has a non-round ovoid exterior cross-section.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Alessio as applied to claim 1 above, and further in view of CHIQUIARI-ARIAS.

D'Alessio teaches the limitations of claim 1 as above, but does not teach the use of a thermoplastic packet to hold the liquid. Rather, D'Alessio only specifies a thin-walled packet.

Chiquiari-Arias discloses a thermoplastic packet for containing liquid to be dispensed (40) by an individual.

It would have been obvious to a person of ordinary skill in the art to use the plastic packets of Chiquiari-Arias in the application device of D'Alessio in order to dispense a precise amount of medication in a disposable container (Chiquiari-Arias Abstract)

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over CHARI (US #5,098,297).

Chari discloses an oral applicator to be used in the method as described in claim 1 (see Abstract), but does not specify that the applicator is designed to be used with a film-forming gel for the treatment of a mouth ulcer. Rather, Chari discloses the use of an aqueous medication solution for the desensitization of a tooth. The Examiner takes the broadest reasonable interpretation of "treating a mouth ulcer" to include the desensitization of the tissue surrounding the ulcer, therefore Chari rejects claim 8. Regarding claim 9, it would have been obvious to a person of ordinary skill in the art to substitute a film forming gel for the sub saturated aqueous solution of Chari in order to treat a mouth ulcer as desired.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DIETRICH (US #2,260,100).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth R. MacNeill whose telephone number is (571)-272-9970. The examiner can normally be reached on 7:00-3:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ERM

Elizabeth MacNeill
8/11/06

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

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